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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/038,126	01/02/2002	Vikrant Sharma	3790-012018	7425

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EXAMINER

NGUYEN, THANH T

ART UNIT PAPER NUMBER

2144

DATE MAILED: 11/15/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/038,126

Applicant(s)

SHARMA, VIKRANT

Examiner

Tammy T. Nguyen

Art Unit

2144

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE (3) MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-13 and 16-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-13 and 16-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 02 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____



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Office Action

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 3, 2005 has been entered.
2. Claims 8, 14, and 15 are cancelled.
3. Claims 1-7, 9-13, 16-26 are presented for examination.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 1-7, 9-14, 16-23, 25, and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by Gabbard et al. (USPN 6,205,432)– Date of Patent: March 20, 2001, herein referred to as “Gabbard”).
6. As to claim 1, Gabbard teaches the invention as claimed, including a system for delivering email-based advertising to discrete users, comprising: (a) a first computer connected to a computer network, the first computer configured to transmit an email message (fig.1 computer 20) including identification data (see col.16, lines 20-30) and one or more email client objects (fig.1, computer 20 transmit email message to computer 12)(fig.6, client Object); (b) the first computer connected to the computer network, the second computer configured to receive the email message from the first computer (fig.1, computer 12, receives email message from computer 20), configured such that in response to displaying the email message the second computer transmits the identification data and the one or more email client objects (see col.16, lines 20-30)(fig.6, Client Object); and (c) at least one server remote from the first and second computer and connected to the computer network (Network server 26, 28, 30), the server configured to receive the identification data and the one or more email client objects (fig.6, Client Object), wherein the server in response to receiving the identification data and the one or more email client objects is configured to select an advertisement , the server configured to transmit the advertisement to the second computer, so that the second computer displays the advertisement in a message field of the email message (fig.13).

7. As to claim 2, Gabbard teaches the invention as claimed, wherein the first computer includes a first email client, the first email configured to embed HTML code into the email message (col.2, lines 35-46).
8. As to claim 3, Gabbard teaches the invention as claimed, wherein the email message is comprised of the HTML code, the HTML code comprised of the identification data and the one or more of the email client objects (Fig.8).
9. As to claim 4, Gabbard teaches the invention as claimed, wherein the identification number identifies a partner, the partner being a user of the first computer system (computer 20).
10. As to claim 5, Gabbard teaches the invention as claimed, wherein the email client objects comprise at least one of the following: (a) a recipient's email address (Fig.6, "recipient"); (b) a subject line; (c) a time of the day; (d) an IP address; and (e) a profile of the partner (a recipient's email address of fig. 12).
11. As to claim 6, Gabbard teaches the invention as claimed, wherein the second computer is comprised of a second email client comprised of an HTML interpreter, the HTML interpreter configured to interpret the HTML code (col.12, lines 35-46).
12. As to claim 7, Gabbard teaches the invention as claimed, wherein the identification data and the one or more email client objects are read from the HTML code (fig.7).
13. As to claim 9, Gabbard teaches the invention as claimed, wherein the server is a banner server, the banner server is programmed to select an appropriate advertisement as a function of the identification data and the one or more of the email client objects (Fig.6, Client Object).

14. As to claim 10, Gabbard teaches the invention as claimed, wherein the banner server is comprised of at least the following: (a) a web server; (b) an application server (fig.1); and (c) a database backend.
15. As to claim 11, Gabbard teaches the invention as claimed, wherein the server is configured to provide an advertisement and optionally an active link associated with the advertisement, to be transmitted to the second computer (see col.7, lines 34-41, and col.3, lines 3-27).
16. As to claim 12, Gabbard teaches the invention as claimed, wherein the first computer and the second computer is configured to utilize instant messaging software or wireless communication software to communicate email messages to and from each other (see col.6, lines 31-65).
17. As to claim 13, Gabbard teaches the invention as claimed, including a method of delivering email-based advertising between a first computer and a second computer on a network, the method comprising the steps of: (a) transmitting to a server on the network identification data and one or more email client objects received in an email from the first computer (see col.16, lines 20-58); (b) receiving, the identification data and optionally one or more of the email client objects at the server, and in response thereto selecting an advertisement (see col.11, lines 5-15, and lines 45-65); (c) transmitting the advertisement, and (d) embedding the advertisement in a message field of the email message, such that the advertisement is displayed on a screen the second computer (fig.1).

18. As to claim 16, Gabbard teaches the invention as claimed, wherein the identification data is an affiliate I.D. number and the email client objects include at least a subject line (fig.6, subject:test).
19. As to claim 17, Gabbard teaches the invention as claimed, wherein the server counts the number of times a particular ad is pulled and sent for attachment to an email message (fig.12).
20. As to claim 18, Gabbard teaches the invention as claimed, wherein the server utilizes counting software to limit the number of times a particular recipient of an email message sees the same ad (see col.11, lines 51-65).
21. As to claim 19, Gabbard teaches the invention as claimed, wherein the server credits a partner, with reference to the identification data, for each time an advertisement is viewed by a unique recipient wherein the partner is a user of the first computer system (fig.1).
22. As to claim 20, Gabbard teaches the invention as claimed, wherein the server instructs billing software to generate a payment, either in the form of electronic payment or printed check, to the partner based on the number of advertisements placed by the server in connection with that partner's identification data (see col.16, lines 20-39).
23. As to claim 21, Gabbard teaches the invention as claimed, wherein the server works in conjunction with billing software to generate bills for advertisers whose advertisements are placed by the server, based on the number of times the advertisements are sent from the server for attachment to an email message (fig.11).

24. As to claim 22, Gabbard teaches the invention as claimed, wherein, in addition to the advertisement, the server sends an active link (URL) to enable a recipient to click on the advertisement and access the advertiser's website (see col.13, lines 1-17).
25. As to claim 23, Gabbard teaches the invention as claimed, wherein the advertisement is one of text and graphics (fig.13).
26. As to claim 25, Gabbard teaches the invention as claimed, including an email message interface comprised of a "from" field a "To" field, a "Subject" field, and an email message text window, wherein a Person-to-Person message and an advertising banner are displayed within the email message text window, further wherein the advertising banner has an active link associated therewith, wherein the advertising banner is a graphic (see fig.11).
27. As to claim 26, Gabbard teaches the invention as claimed, wherein the interface is displayed on a first computer, and wherein the advertising banner is transmitted to the first computer by a server in response to the server receiving one or more email client objects from a second computer (fig.1).

Claim Rejections - 35 USC § 103

28. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

29. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gabbard et al., (hereinafter Gabbard) U.S. Patent No.6,205,432 in view of Shaw et al., (hereinafter Shaw) U.S. Patent No. 6,199,106.

30. As to claim 24, Gabbard does not explicitly teach the advertisement includes an active link associated therewith. However, Shaw teaches the advertisement includes an active link associated therewith (link 800 of figure 12). It would have been obvious to one of ordinary skill in the art at the time of the invention was made to implement the teachings of Shaw into the computer system of Gabbard to have an advertisement includes an active link associated therewith because it would have provided specific functions that when clicked bring you to another place within the document or to another document altogether.

Conclusion

31. Any inquiries concerning this communication or earlier communications from the examiner should be directed to **Tammy T. Nguyen** who may be reached via telephone at **(571) 272-3929**. The examiner can normally be reached Monday through Friday between 8:00 a.m. and 5:00 p.m. eastern standard time.

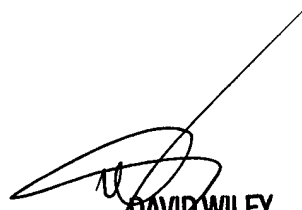
If you need to send the Examiner, a facsimile transmission regarding this

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instant application, please send it to **(703) 872-9306**. If attempts to reach the examiner by telephone are unsuccessful, the Examiner's Supervisor, David Wiley, may be reached at **(571) 272-3923**.

TTN

November 10, 2005



DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100